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08/319,490 10/07/94 ESCH

H 21633593200F

EXAMINER

HENDRICKSON, S

11M1/1006

ART UNIT

PAPER NUMBER

10

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1103

DATE MAILED:

10/06/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8/1/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-7 are pending in the application.
Of the above, claims 2-6 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1 and 7 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-7 were are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit: 1103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(1). Correction of the following is required: there is no disclosure of "DBP/CTAB=3.5 to 3.9".

Claims 1 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The parameters in claim 1 are somewhat inconsistent; the CTAB cannot be more than 86 or else there would be a conflict with the DBP/CTAB.

b) In claim 1 lines 7-8, "(ml= ... consumption)" is unclear as to what it means, if it limits the claim and what is intended to be within the parentheses. If the amount of NaOH of a certain concentration required to neutralize the material is meant, it should be clearly stated.

c) In line 12 of claim 1, V_1 and V_2 are undefined.

Claim 7 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 7 broadens the range of DBP/CTAB.

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Claims 1 and 7 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Lagarde et al.

The reference teaches in col.2 lines 5-35 and col.9 lines 1-10 silica having BET 242, CTAB 237, BET/CTAB=1.02. The other properties, to the extent the claim can be comprehended, are deemed inherently possessed since the BET, CTAB and their ratio are the same as claimed; where the examiner has found substantially the same product as claimed in the art but cannot determine whether the reference inherently meets the claimed limitations, the burden is upon the applicant to show a difference; In re Fitzgerald et al. 205 USPQ 594.

To the extent that the examples are not considered anticipatory, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make silica having the claimed properties since doing so provides a fine silica having properties desired by Lagarde col. 1 lines 65-68. With regard to the overlapping general values disclosed in col. 2 lines 1-35, (also taught is a particle size of essentially less than 45 microns), the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been

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held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549.

Applicant's arguments filed 8/1/95 have been fully considered but they are not deemed to be persuasive.

The intended use of the material does not limit it; no differences in the product claimed have been shown. There are no limitations as to the sodium content. Note that the amendment to line 12 appears to be an error; the claim clearly is not limited to the features argued.

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The last 9 lines should be deleted and the DBP/CTAB corrected.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

**WAYNE LANGE
PRIMARY EXAMINER
GROUP 110**